

Remarks

This Application has been carefully reviewed in light of the Office Action mailed August 27, 2004. Applicant appreciates the Examiner's consideration of the Application. Applicant has made a clarifying amendment to independent Claims 1, 17, 32, and 48. These amendments are not considered narrowing or necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Objection to the Specification

The Examiner objects to the Abstract as exceeding one hundred fifty words. Applicant has provided a replacement Abstract, the length of which does not exceed one hundred fifty words. These amendments should not be interpreted so as to limit the scope of Applicant's disclosure or claims but are made solely to bring the Abstract's length to within the one hundred fifty word limit. For at least these reasons, Applicant respectfully requests that the Examiner withdraw the objection to the Specification.

II. Applicant's Claims Comply with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 5-7, 15, 21-23, 31, 36, and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner argues that the terms "substantially" and "essentially" are relative terms that render the rejected claims indefinite. (*See* Office Action, Page 2) Applicant respectfully disagrees.

Applicant notes that the essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Furthermore, the test for indefiniteness under Section 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). Applicant respectfully submits that the meaning of Claims 5-7, 15, 21-23, 31,

36, and 46 would be clear to one of ordinary skill in the art at the time of invention such that these claims comply with 35 U.S.C. § 112, second paragraph. Applicant discusses Claims 5 and 15 as examples.

The relevant portion of dependent Claim 5 recites the following:

the test server engine is further operable to generate a test results web page comprising test results for a plurality of software GUI test instances, including the test result for the most recently executed software GUI test instance, ***substantially immediately*** upon receiving the test result from the particular distributed test execution computer on which the most recently executed software GUI test instance was executed.

The M.P.E.P. and the courts clearly condone the use of the term “substantially” in claims. *See* M.P.E.P. § 2173.05(b).D citing *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 U.S.P.Q.2d 2010 (Fed. Cir. 1988). Moreover, Applicant respectfully submits that the meaning and scope of Claim 5 would be clear to one of ordinary skill in the art at the time of invention, whether the claim is read alone or in combination with the Specification. For example, Applicant respectfully directs the Examiner attention to at least Page 4, Line 29 through Page 5, Line 7 and Page 11, Lines 21-31, which provide example descriptions corresponding to this claim. Claim 5 and its dependent claims are therefore definite. For substantially similar reasons, Claims 21 and 36 and their dependent claims are definite.

The relevant portion of dependent Claim 15 recites the following:

each test execution computer operates ***essentially*** as an automated test execution robot, repeatedly requesting, receiving, executing, and returning test results for software GUI test instances, automatically and without human intervention, for an extended period.

The M.P.E.P. and the courts clearly condone the use of the term “essentially” in claims. *See* M.P.E.P. § 2173.05(b).B citing *In re Marosi*, 710 F.2d 799, 218 U.S.P.Q. 289 (C.C.P.A. 1983). Moreover, Applicant respectfully submits that the meaning and scope of Claim 15 would be clear to one of ordinary skill in the art at the time of invention, whether the claim is read alone or in combination with the Specification. For example, Applicant respectfully directs the Examiner attention to at least Page 5, Lines 8-23 and Page 9, Line 12 through Page 10, Line 21, which provide example descriptions corresponding to this claim.

Claim 15 is therefore definite. For substantially similar reasons, Claims 31 and 46 are definite.

The scope of Claims 5-7, 15, 21-23, 31, 36, and 46 is reasonably ascertainable by those skilled in the art and thus the claims are not indefinite. *See* M.P.E.P. § 2173.05(e) (citing *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992)). Applicants respectfully request the Examiner to withdraw the rejections under 35 U.S.C. § 112, second paragraph.

III. Applicant's Claims are Allowable over the Proposed *Parker-Estep* Combination

The Examiner rejects Claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,600,789 to Parker, et al. ("*Parker*") in view of U.S. Patent 6,766,481 to Estep, et al. ("*Estep*").¹ Applicant respectfully disagrees and discusses independent Claim 1 as an example.

A. The Proposed *Parker-Estep* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1

Parker merely discloses a system for automated GUI interface testing. The system disclosed in *Parker* includes three major components: a test script, a test executive, and a test driver. (See Column 3, Line 67 through Column 4, Line 13) The test script contains the user events to be simulated, and also includes the control and data structures necessary to validate the GUI's, and in turn the application program's responses to the inputs. (See Column 4, Lines 2-6) The test executive executes the test script. (See Column 4, Lines 8-10) The test driver provides for the actual GUI interface by taking GUI-specific references from the test executive and performing the actual interface to the GUI objects. (See Column 4, Lines 12-16) *Parker* discloses one distributed example of its system. (See Figure 15 and associated text) According to that example, the same test script, executed by a single test executive, is

¹ Assuming for the sake of argument that *Estep* could be properly combined with *Parker* as the Examiner suggests, Applicant respectfully submits that, as discussed below, patentable distinctions would still exist between Claims 1-48 and the proposed *Parker-Estep* combination. However, Applicant notes at the outset that Applicant could antedate *Estep* based at least on Applicant's date of conception and reduction to practice prior to April 24, 2001 (the effective filing date of *Estep*). While Applicant has chosen not to do so in the present Response due to the clear distinctions between Applicant's claims and the Examiner's proposed *Parker-Estep* combination discussed below, Applicant reserves the right to antedate *Estep* in a future Response or on Appeal, if appropriate.

able to drive three different GUIs on two different machines. (See Column 33, Lines 54-56; Figure 15)

However, *Parker*, whether considered alone, in combination with *Estep*, or in combination with knowledge generally available to those of ordinary skill in the art at the time of invention fails to disclose, teach, or suggest various limitations recited in Applicant's claims.

For example, *Parker* fails to disclose, teach, or suggest "a centralized test queue operable to store a plurality of software GUI test instances to be executed by a plurality of distributed test execution computers, each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed," as recited in Claim 1. According to *Parker*, the test executive located on a particular machine executes the test script and, whether the tested machine is the particular machine (*see* Figure 4) or another machine (*see* Figure 15), communicates the user events to be generated (based on execution of the test script) to the machine. Thus, *Parker* fails to disclose, teach, or suggest "a centralized test queue operable to store a plurality of software GUI test instances ***to be executed by a plurality of distributed test execution computers***," as recited in Claim 1. Additionally, even assuming that there was the required teaching, suggestion, or motivation to combine *Parker* with *Estep* in the manner the Examiner proposes (which, as discussed below, there is not) and even assuming that *Estep* did qualify as prior art (which it does not), *Estep* would still fail to make up for this deficiency of *Parker*.

The Examiner acknowledges, and Applicant agrees, that *Parker* fails to disclose "each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed," as recited in Claim 1. However, the Examiner argues that *Estep* does disclose these limitations. Applicant respectfully disagrees. Even assuming that there was the required teaching, suggestion, or motivation to combine *Parker* with *Estep* in the manner the

Examiner proposes (which, as discussed below, there is not) and even assuming that *Estep* did qualify as prior art (which it does not), *Estep* would still fail to make up for this deficiency of *Parker*.

Estep discloses a process for testing commercial, off-the-shelf software products to determine functionality for specific criteria and presenting decision-making information in an interactive web-based repository. (Column 1, Lines 13-17) The cited portions of *Estep* merely disclose the following:

- Specifically, the NPLACE 110 determines the various component areas that make up the architecture of the desired software system. That is, the NPLACE 110 determines which different product lines of software, e.g., word processor or database management system, are needed in the implementation of the target system. (Column 4, Lines 6-11)
- The research component area module 202 is shown in FIG. 3. In this module 202, an NPLACE 110 customer 114 determines the component areas required for building the target software system. More particularly, the customer 114 determines what software product lines, e.g., word processor, database management system, network management system, etc. are needed to design, develop, and implement a larger, target software system. (Column 4, Lines 59-66)

The Examiner apparently interprets these portions of *Estep* as disclosing “information regarding various network platform combinations” and argues that it would have been obvious to include such information in a GUI test environment. (Office Action, Page 6) Even assuming for the sake of argument that the Examiner’s interpretation of *Estep* is accurate, and even if the Examiner was correct that including “information regarding various network platform combinations in a GUI software test environment . . . allows for more fully testing of the software,” it would still have no bearing on Applicant’s claims since they do not merely “include information.” Instead, Claim 1 recites that “each distributed test execution computer compris[es] a client platform and [is] coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed.”

As another example, *Parker* fails to disclose, teach, or suggest a test server engine operable to, for each of the plurality of test execution computers, perform the following

limitations recited in Claim 1:

- receive a request for a software GUI test instance from a particular distributed test execution computer in response to completion of a preceding software GUI test instance by the particular distributed test execution computer;
- retrieve a software GUI test instance from the test queue in response to the request;
- communicate the retrieved software GUI test instance to the particular distributed test execution computer for execution against a particular client-server combination using a testing component supported by the particular distributed test execution computer, the testing component operable to perform automated software GUI testing and to produce test results for such testing for communication to the test server engine;
- receive a test result for the software GUI test instance from the particular distributed test execution computer in response to execution of the software GUI test instance; and
- store the received test result for reporting to one or more users.

As discussed above, in *Parker* a centralized test executive is responsible for execution of a test script and controls the scheduling and performance of tests. This is true even in *Parker's* “distributed” example.

Nowhere does *Parker* disclose, teach, or suggest a test server engine operable to, for each distributed test execution computer, “receive a request for a software GUI test instance from a particular distributed test execution computer in response to completion of a preceding software GUI test instance by the particular distributed test execution computer.” Instead, the test executive in *Parker* executes the test script and communicates the user events to be simulated to the test driver. Indeed, the portion of *Parker* cited by the Examiner merely supports this distinction – “If the test was successful, **the test executive** continues to execute the next step in the script” (See Office Action, Page 4 citing Column 4, Lines 44-46; emphasis added) *Parker* fails to disclose, teach, or suggest a test server engine operable to, for each distributed test execution computer, “receive a request for a software GUI test instance from a particular distributed test execution computer,” as recited in Claim 1. There is simply no such request in *Parker*. In fact, it would make little sense for the system disclosed in *Parker* to incorporate such a request because the centralized test executive drives the execution of the test scripts. Even more clearly, the system disclosed in *Parker* does not receive such a request “in response to completion of a preceding software

GUI test instance by the particular distributed test execution computer,” as recited in Claim 1. For example, with respect to the distributed example disclosed in *Parker*, *Parker* states that “the test script, 800, in FIG. 15 can request 5 machines to access a database simultaneously, and then specify a rendezvous point in the test script that gains control only when all five have finished executing their parallel activities.”

Parker also fails to disclose, teach, or suggest a test server engine operable to “retrieve a software GUI test instance from the test queue in response to the request from the particular test execution computer,” as recited in Claim 1. This true at least because *Parker* fails to disclose, teach, or suggest the “centralized test queue” and “the request,” as discussed above. Additionally, the portion of *Parker* cited by the Examiner as disclosing this element of Claim 1 (prior to the amendment presented in this Response) clearly fails to disclose, teach, or suggest “retriev[ing] a software GUI test instance from the test queue in response to the request from the particular test execution computer,” as recited in Claim 1 as amended.

Based on the above-described distinctions, it is clear that *Parker* also fails to disclose, teach, or suggest at least the following limitations recited in Claim 1:

- communicate the retrieved software GUI test instance to the particular distributed test execution computer for execution against a particular client-server combination using a testing component supported by the particular distributed test execution computer, the testing component operable to perform automated software GUI testing and to produce test results for such testing for communication to the test server engine;
- receive a test result for the software GUI test instance from the particular distributed test execution computer in response to execution of the software GUI test instance; and
- store the received test result for reporting to one or more users.

For at least these reasons, Applicant respectfully submits that independent Claim 1 and its dependent claims are allowable over the Examiner’s proposed *Parker-Estep* combination. For analogous reasons, Applicant respectfully submits that independent Claims 17, 32, and 47-48, and their dependent claims are allowable over the Examiner’s proposed *Parker-Estep* combination.

B. The Proposed *Parker-Estep* Combination is Improper

Applicant respectfully submits that the Examiner's proposed combination of *Parker* and *Estep* is improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Parker*, *Estep*, or the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Estep* with *Parker* in the manner the Examiner proposes. The rejected claims are allowable for at least this additional reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability

of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.² According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an

² Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With respect to the Examiner's proposed combination of *Estep* with *Parker*, the Examiner merely summarizes certain teachings of *Estep* and states, "Therefore, it would have been obvious to one of ordinarily skill in the art at the time of the invention to include

information regarding various network platform combinations in a GUI software test environment, as that allows for more fully testing of the software.” (Office Action, Page 6) First, Applicant’s Claim 1 recites that “each distributed test execution computer compris[es] a client platform and [is] coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed.” As discussed above, even assuming for the sake of argument that the Examiner’s interpretation of *Estep* is accurate, and even if the Examiner was correct that including “information regarding various network platform combinations in a GUI software test environment . . . allows for more fully testing of the software,” it would still have no bearing on Applicant’s claims since they do not merely “include information.”

Moreover, nothing in *Parker*, *Estep*, or knowledge generally available to those of ordinary skill in the art at the time of the invention teaches, suggests, or motivates in any way the proposed combination of the automated GUI testing techniques disclosed in *Parker* with the software test techniques disclosed in *Estep*.³ The Examiner’s speculation that “it would have been obvious” at the time of the invention to combine the teachings of *Parker* with *Estep* to allegedly achieve Applicant’s invention, in hindsight with the benefit of Applicant’s claims as a roadmap for selecting portions of multiple references, is clearly insufficient under the M.P.E.P. and governing Federal Circuit case law.

The Examiner did nothing more than point to a teaching of *Estep* and propose an alleged advantage of combining *Estep* with *Parker* (and one which Appellants do not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner did not point to any relevant portions of either *Parker* or *Estep* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the teachings of *Parker* with the teachings of *Estep*. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the teachings of *Parker* the teachings of

³ Applicant requests that if the Examiner relies on “common knowledge” or “well known” art to combine the references, the Examiner provide a reference in support of this position pursuant to M.P.E.P. § 2144.03, or if the Examiner relies on personal knowledge to supply the required teaching, suggestion, or motivation to combine, the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. 2144.03.

Estep. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the teachings of *Parker* the teachings of *Estep*, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

Applicant respectfully notes that “the factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001). Thus, the burden is on the Examiner to identify concrete evidence in the record to support his conclusion that it would have been obvious to modify the teachings of the cited references to achieve the claimed invention. *See, In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000). The Examiner’s conclusory assertion that it would have been obvious to combine *Parker* with *Estep* to allow “for more fully testing of the software” fails to provide a thorough and searching factual inquiry and does not identify any concrete evidence in the record for combining these references.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Parker* with *Estep* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner’s conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicant respectfully submits that the Examiner’s proposed combination of *Parker* with *Estep* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicant’s claims and is unsupported by the teachings of *Parker* and *Estep*. Applicant respectfully submits that the rejection must therefore be withdrawn.

Additionally, as demonstrated above, Applicant respectfully submits that *Parker* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Estep* did disclose the portions of Claim 1 that the Examiner suggests (which it does not), even assuming that *Estep* did qualify as prior art, and even assuming that there was the required teaching, suggestion, or motivation to combine *Parker* with *Estep* as the Examiner proposes (which there is not), the proposed *Parker-Estep* combination would still fail to disclose,

teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

C. Conclusion

For at least these reasons, the proposed *Parker-Estep* combination fails support the obviousness rejection of independent Claim 1 and its dependent claims. For analogous reasons, the proposed *Parker-Estep* combination fails to support the obviousness rejections of independent Claims 17, 32, and 47-48, and their dependent claims. Thus, Applicant respectfully requests reconsideration and allowance of Claims 1-48.

IV. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the various references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Although Applicant believes that no fees are due, the Commissioner is hereby authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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